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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/697,780

10/26/2000

Bruce L. Davis

60320

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23735 7590 02/10/2006

DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

EXAMINER

JEAN, FRANTZ B

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/697,780

Applicant(s)

DAVIS ET AL.

Examiner

Frantz B. Jean

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18,32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/14/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to applicant's amendment filed 11/14/2005. Claims 1-18 are still pending in this office action. Claims 32-33 have been added in the application.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 11/14/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The amendment filed on 11/14/05 has been entered in the file.

#### ***Claim Rejections - 35 USC § 112***

Claims 2-4 recite the limitation "first data structure". There is insufficient antecedent basis for this limitation in the claim.

Claims 7-8 recite the limitation "said identifier". There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jansen et al. US patent number 6,243,450 (Applicants' IDS) in view of Jacobson US patent Number 6,488,205.

Art Unit: 2151

As per claims 1 and 5, Jansen teaches a method of accessing a web page from a publicly accessible internet device (see fig 1, col. 1 lines 19-24), comprising: presenting an object to said device (a credit card is inserted by user in the device, col. 10 line 8); sensing said object (card reader, 30 fig 4); decoding data produced by said optical sensor to yield an object identifier (the card reader presents a code to the microprocessor indicating that a credit card has been inserted in order to identify/select a payment method, col. 10 lines 8-15); consulting a data structure associated to determine whether a web page corresponding to said object identifier is among those sponsored by a third party, so that user access to such web page is permitted without charge (col. 10 lines 1-6; col. 12 lines 34-40, the sponsor (advertiser or third party) allows the user to access the web free of charge for a preset amount of time before it begins charging the user); if so, linking to said web address (vendor/sponsor service is free of charge see col. 1 lines 54-58); and if not, soliciting payment information from a user before linking to said web address and funding certain costs associated with providing the no-charge user linking to sponsored web pages by periodically charging said third party therefor (if other site beyond the vendor is visited a fee is charged to user before or after usage, see col. 10 lines 1 et seq). Jansen does not explicitly disclose that the object was sensed with an optical sensor. Jacobson discloses a sensor system that uses optical technology (108, 109, 101) to detect/sense information on an information card 111 (see col. 6 lines 30-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Jacobson sensor system to Jansen in order to detect/sense a variety of encoded information on information card. One of ordinary skill in the art at the time of the invention would have used an optical sensor to detect information on an object because of its various and multipurpose uses (see Jacobson col. 6 lines 36-39).

As per claims 2-3, Jansen teaches the method of claim 1 in which said first data structure is associated with a proxy server (see fig 2), which is co-located with the device.

As per claim 4, Jansen teaches the method of claim 1 in which said first data structure is stored at a location remote from the device (26, fig 2).

As per claim 6, Jansen teaches if free access to the computer address is determined not to be permitted, informing a user that free access is not available and permitting the user to link to said computer address on a payment basis (see col. 4 lines 3-19).

As per claim 7, Jansen teaches the method of claim 5, which includes accessing a database record in accordance with said identifier, and obtaining from said database record a computer address corresponding thereto (col. 4 lines 50 et seq).

As per claim 8, Jansen teaches the method of claim 5 in which said identifier (col. 5 line 67; col. 9 lines 50 et seq) comprises said computer address.

As per claims 9 and 10, Jansen coding/decoding implicitly comprises decoding a barcode and a digital watermark (see col. 10 lines 1-22).

Art Unit: 2151

As per claims 11-12, Jansen implicitly teaches a computer address that is a URL associated with a root domain, and if free linking to said address is permitted, then also permitting free linking to other URLs associated with said root domain; and a computer address that is a URL associated with a root domain, and said determining includes comparing said root domain with a list of domains to which access is to be freely permitted (see col. 4 lines 29-49).

As per claims 13-14, Jansen implicitly teaches a method of claim 5 in which said determining includes checking a list comprising address data to which free linking is permitted (see col. 1 lines 54-60; col. 4 lines 3-20; col. 1-7); and in which said list is stored in a data structure located remotely from said device (see also col. 9 lines 20-40).

As per claim 15, Jansen teaches a method of claim 14, which includes caching at least some data from said list at said device (see col. 4 lines 3-20; col. 5 lines 33 et seq; col. 9 lines 20-40).

As per claims 16-17, Jansen implicitly teaches a list that includes at least first and second domains, having first and second sponsors (vendors) respectively associated therewith, the method further including billing the first sponsor for free user access provided to the first domain, and billing the second sponsor for free user access provided to the second domain; and billing a sponsor a fee for access that is provided free to a user, wherein certain URLs associated with said sponsor are among computer addresses to which access is provided to users for free (see col. 4 lines 3-20; col. 5 lines 33 et seq and col. 9 lines 18-40).

As per claim 18, Jansen teaches a method of claim 17 that includes: accessing a database record in accordance with said identifier; obtaining from said database record a computer address corresponding thereto; and providing at least some of said fee to an entity that maintains said database record (see col 9 lines 20 et seq and col. 5 lines 33 et seq).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by

Jansen et al. US patent Number 6,243,450 (Applicant's IDS).

Art Unit: 2151

As per claim 32, Jansen teaches a method of accessing a web page from a device (see fig 1, col 1 lines 19-24) comprising: identifying a web page that a user desires to view (fig 8, element 228; col 1 lines 39-44); checking whether said web page is in a class of web pages for which said device permits free viewing, said checking including checking root domain of said desired web page against a data structure having stored therein a catalog of root domains (col. 1 lines 54-56; col. 10 lines 1-6; col. 12 lines 34-40; col. 4 lines 29-49 and 3-20; since Jansen database contain or store the sites that are free and the ones that are not, upon the user request to see a particular site a match is done in order to indicate the free service; therefore, Jansen teaches the feature of checking a root domain); if said checking indicates that free viewing is permitted, then displaying said desired web page (vendor/sponsor service is free of charge col. 1 lines 54-58); if said checking does not indicate that free viewing is permitted, then soliciting payment from the user prior to displaying said desired web page if user would like to visit other sites beyond the vendor, a fee is charged before usage (col. 1 lines 54 et seq; col. 10 lines 1 et seq).

As per claim 33, Jansen teaches sensing data from an article presented to a sensor (fig 4 element 30); producing an article identifier by reference to said sensed data; querying a data structure with said data that includes said article identifier; and receiving back from said data structure a web page address (the reader presents a code to the microprocessor indicating that a credit card has been inserted in order to identify/select payment method so the user can view the web page requested col. 10 lines 8 et seq).

### ***Response to Arguments***

Applicant's arguments filed 11/14/05 have been fully considered but they are not persuasive.

Applicants argued that Jansen does not teach: a web page sponsor by a third party, so that access to such web page is permitted without charge.

Examiner respectfully submits that Applicants' interpretation of the prior art is inaccurate.

Jansen teaches a sponsor web site where service is permitted without charge for a preset period of time (see col. 10 lines 1 et seq; col. 12 lines 34-40). Furthermore, Jansen broadly state that some sites (the vendor/sponsor) can be viewed free of charge col 1 lines 54-58. Although Jansen does not explicitly state a particular site, it must be

noted any site sponsored by a vendor that allows a user to browse article related to that particular vendor is free. Therefore, that vendor/sponsor site falls in the category of Jansen Broad statement regarding free service. In addition, King was cited as prior art, but not used. However, in the last office action Applicant was requested to consider King's prior art. No statement was made regarding King in the applicant's remarks filed on 11/14/2005. Accordingly, the rejection is maintained.

The following prior art contains limitations that are relevant to the claimed invention. Applicant is requested to consider the prior art of record upon responding to this office action.

**King et al (6,904,450) discloses a web page sponsor by a third party, so that access to such web page is permitted without charge (see col. 16 lines 35 et seq).**

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean



**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**